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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/280,518 04/05/99 FUJITWARA

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MM91/1009
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EXAMINER

YOCKEY, D

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/280,518

Applicant(s)

FUJIWARA, KENSUKE

Examiner

David Yockey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant holds that the disclosure does not indicate that the small interval intensity value steps are changed, asserting that the same small range is used repeatedly during each repeated loop process from steps S4 - S7 illustrated in Fig. 1. The Examiner respectfully disagrees with this interpretation of the disclosure, as further discussed below. However, assuming, *arguendo*, that Applicant's position is supported by the disclosure, there is no teaching in the original disclosure as to how the laser intensity can reach the finish condition if the loop process from steps S4 - S7 is ever repeated. This is particularly because the results for each iteration would be the same for an ordinary photoreceptor and the loop process would continue indefinitely. While such a process may function as asserted by Applicant in the event that the photoreceptor has a major aberration on the surface thereof, i.e. the photoreceptor is defective, there is no indication that the invention is directed to such a circumstance. The photoreceptor indicated in the original disclosure is merely a

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"photoreceptor", indicating to one of ordinary skill in the art an ordinary, non-defective photoreceptor.

Additionally, there is no indication as to how the same selection can be performed on each pass through the loop when a different laser intensity corresponding to the potential nearest to the desired potential will be present on the pass through the loop for course intervals and passes through the loop for fine intervals. According to Applicant's position, on the first pass through step S7, laser intensities at fine intervals are selected in the vicinity of the laser intensity which corresponds to the one of the potentials $P_{MAX} \times (920/1023)$, $P_{MAX} \times (940/1023)$, $P_{MAX} \times (960/1023)$, $P_{MAX} \times (980/1023)$, and $P_{MAX} \times (1000/1023)$, while on the second pass through step S7, laser intensities at the same fine intervals are selected in the vicinity of the laser intensity which corresponds to the one of the potentials $P_{MAX} \times (950/1023)$, $P_{MAX} \times (952/1023)$, $P_{MAX} \times (954/1023)$, $P_{MAX} \times (956/1023)$, and $P_{MAX} \times (958/1023)$. There is no indication in the disclosure how the same result is obtained from step S7 given different input thereto.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite with respect to whether or not the steps therein are directed to repeated change of the interval in the second potential detecting step. In

claim 1, it is unclear whether or not the second plurality of selected values differs for each repetition of the step. In claim 2, it is unclear whether or not the second plurality of laser intensity values differs for each repetition of the step. It is the Examiner's position that the claims do not limit the invention such that these characteristics of the invention do not change. Applicants' position is that the claims are so limited. Do to the disagreement in this regard, the claims are deemed to be so unclear as to preclude consideration in view of the prior art.

Response to Arguments

Applicant's arguments filed 26 July 2001 have been fully considered but they are not persuasive.

Applicant argues that only one set of fine interval step intensity values is given in the invention and no additional change of the small intensity interval is performed in the invention as originally disclosed. After careful consideration of Applicant's remarks and the original disclosure, the Examiner must respectfully disagree. At page 6, line 23 through page 7, line 4, the disclosure states "When there is not obtained the desired preset potential, there are repeated operations of exposing photoreceptor surface portions to laser lights of a plurality of *further finely divided laser intensities* and, detecting the respective potentials, until there is obtained potential equal to or substantially equal to the predetermined set potential" (emphasis added). The phrase "further finely divided laser intensities" clearly indicates that, in each repetition, the laser intensities are divided finely to a greater degree or extent. The phrase "further finely

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divided" is also found at page 12, lines 8-9. While the exemplary values noted at page 12, lines 9-11 are used in the loop process, lines 12-13 of page 12 state "Then, using these laser intensities thus selected, the operations of the steps S4 - S6 are repeated" (emphasis added). There is no indication that the same values are carried over to the next iteration of the loop; there is only an example of a set of values for a first fine pass. In fact, lines 13-15 clearly indicate that step S7, selecting laser intensities, is repeated in each iteration. This selection is a selection of fine intervals in the vicinity of the laser intensity which corresponds to potential nearest to the desired potential, as clearly stated in step S7 of Fig. 1. As discussed in the enablement rejection above, there is no indication as to how the same selection can be performed on each pass through the loop when a different laser intensity corresponding to the potential nearest to the desired potential will be present on the pass through the loop for course intervals and passes through the loop for fine intervals. In view of these facts, the disclosure is seen to suggest to one of ordinary skill in the art a selection of increasingly fine divisions for each iteration of the loop process until the laser intensity satisfies the finish condition.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Yockey whose telephone number is (703) 308-3084. The examiner can normally be reached on weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on (703) 308-0750. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DAVID F. YOCKEY
PRIMARY EXAMINER

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October 8, 2001